

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing reasons that follow. Claims 1-6 remain pending in this application.

Claim Rejections under 35 U.S.C. § 103

Claims 1-6 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2006/0094432 (“Chang”) in view of U.S. Patent Publication No. 2006/0094432 (“Leonard”). In response, Applicant traverses the rejection for the reasons set forth below.

Applicant relies on MPEP § 2143, which requires that all the claim limitations be considered. Considering all the claim limitations as required by MPEP § 2143.03, the cited references do not identically disclose, teach or suggest all the claim limitations. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicant respectfully submits that the combination of the cited references does not disclose, teach or suggest each and every element of the claims.

Independent claim 1 is directed to a method for testing a handover function in a mobile communication system. The mobile communication system includes a mobile station, base station radio apparatuses that perform communication with the mobile station and a radio base station control apparatus that controls transmission powers for the base station radio apparatuses. The claimed method includes the steps of: calculating a difference between levels of reception fields for the base station radio apparatuses that cover the cells for which the handover test of the mobile terminal is to be performed; a step of controlling transmission powers of the base station radio apparatuses so that a difference is equal to or smaller than a predetermined threshold value; and a step of performing the handover function test between the cells covered by the base station radio apparatuses, the difference between the levels of the reception fields of which is equal to or smaller than the threshold value.

In contrast, the cited references not disclose, teach or suggest each and every element recited in independent claim 1. For example, Chang is directed to a handoff method for a mobile communication system. In the Office Action, the Examiner asserts that paragraph 16 and 38 identically disclose “calculating a difference between levels of reception fields for the base station radio apparatuses that cover the cells for which the handover test of the mobile terminal is to be performed” as claimed in claim 1. However, as stated by the

Examiner, the cited passages disclose “measuring signal strength of signals received by a mobile station from an active base station and comparing the measured signal strength of the active base station with a first threshold value” which is not in anyway identical to “calculating a difference between levels of reception fields for the base station radio apparatuses that cover the cells for which the handover test of the mobile terminal is to be performed.”

Accordingly, Chang fails to disclose “calculating a difference between levels of reception fields for the base station radio apparatuses that cover the cells for which the handover test of the mobile terminal is to be performed” as claimed in independent claim 1. Claims 2-6 depend from independent claim 1 and should be allowed for the reasons set forth above without regard to further patentable limitations contained therein. Further, Leonard fails to cure the deficiencies of Chang.

In addition, concerning claim 3, Applicant notes that the Examiner relies upon inherency. However, the Examiner has not provided any evidence or rationale tending to show inherency. In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Here, the Examiner has not provided any evidence to support a determination that claim 3 contains inherent characteristics. Therefore, for this additional reason the rejection of claim 3 is improper and Applicant requests that the rejection be withdrawn and claim 3 be allowed.

If this rejection of the claims is maintained, the examiner is respectfully requested to point out where the above-mentioned features are disclosed in the cited references.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

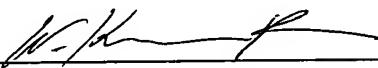
The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing or a credit card payment form being unsigned, providing incorrect information resulting in a rejected credit card transaction, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 10/30/08

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 945-6014
Facsimile: (202) 672-5399

By



George C. Beck
Attorney for Applicant
Registration No. 38,072

W. Keith Robinson
Attorney for Applicant
Registration No. 59,396